

PATENT APPLICATION

CERTIFICATE OF MAILING/FACSIMILE TRANSMISSION (37 CFR 1.8)

I hereby certify that this paper (along with any paper referred to as being transmitted therewith) is (XXX) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box. 1450, Alexandria, Virginia 22313-1450 or () being transmitted by facsimile to the U.S. Patent and Trademark Office. (Fax No. 571 273 8300) (pages). This facsimile is being sent from (908) 429-3650.

Maria T. Sanchez
(Print Name)

Date: February 13, 2008

Maria T. Sanchez
(Signature)

DOCKET NO. 2002DE422

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Uwe FALK et al.

Art Unit: 1761

Serial No. 10/518,315, filed December 16, 2004

Examiner: To Be Assigned

For: **USE OF COLLOIDAL ANIONIC SILICA SOLS AS CLARIFYING AGENTS**

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR
§1.97(b)

February 13, 2008

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In accordance with the duty of disclosure provisions of 37 CFR §1.56, there is hereby provided certain information which the Examiner may consider material to the examination of the subject U.S. patent application. It is requested that the Examiner make this information of record if it is deemed material to the examination of the subject application.

1. Enclosures accompanying this Information Disclosure Statement are:

1a. ☒ Form PTO-1449.

1b. ☒ The following documents are enclosed:

- (i) Copy of opposition filed against EP 1520007B1 (corresponds to present application) dated 12 December 2006.
- (ii) Additional letter filed in opposition against EP 1520007B1 dated February 26, 2007.
- (iii) Additional letter filed in opposition against EP 1520007B1 dated March 13, 2007.
- (iv) Product specification of Blankasit® and translation (D11 in opposition).
- (v) Product specification of Klar-Sol Super and translation (D12 in opposition).
- (vi) S. Görtges, Rohwareeinfluß auf Klärung und Stabilisierung beim Apfelsaft, Flüssiges Obst, 1/1980, pp 16-19, 46-52 (D13 in opposition).
- (vii) H. Trogus, Weinklärung mit Kiesel-Gelatine-Schönungen, Der Badische Winzer, 9/1983, pp 468-72 (D14 in opposition).
- (viii) Haushofer et al., Ergebnisse eines Großversuches mit dem Wein-Schönungsmittel Kieselso, Mitt., 21, 1991 (D16 in opposition).

- (ix) K. Wucherpennig und Ph. Possmann, Beitrag zur kombinierten Gelatine-Kiesel­sol-Schönung, Flüssiges Obst, 39, 1972 (D17 in opposition).
- (x) English language abstract of K. Wucherpennig und Ph. Possmann, Beitrag zur kombinierten Gelatine-Kiesel­sol-Schönung, Flüssiges Obst, 39, 1972.
- (xi) K. Raible et al., Behandlung der heißen Ausschlagwürze mit Kiesel­sol, Brauwelt Nr. 13, 1985, pp 540-546 (D18 in opposition).
- (xii) Kiesel­säuresol als Bierstabilisierungsmittel, Brauwelt Nr. 13, 1983, pp 495-497 (D19 in opposition).
- (xiii) G. Sommer und F. Boback, Verbesserung der Filtrierbarkeit, Brauwelt Nr. 4, 1988, pp 117-121 (D20 in opposition).
- (xiv) K. Raible et al., Kiesel­säuresol - ein Bierstabilisierungsmittel zur Verbesserung der Filtrationseigenschaften von Bier, Monatsschrift für Brauwissenschaft, Heft 2, 1983, pp 76-82 (D21 in opposition).
- (xv) K. Raible et al., Kiesel­säuresol - ein Bierstabilisierungsmittel zur Verbesserung der Filtrationseigenschaften von Bier, Monatsschrift für Brauwissenschaft, Heft 3, 1983, pp 113-119 (D22 in opposition).

The following documents, although identified in the opposition papers, are not being enclosed and are not being listed on PTO Form 1449 as they have been previously disclosed in prior IDS (identified after each document):

D1	DE-OS-1642769	(IDS dated August 25, 2005)
D2	DE-OS-2408896	(IDS dated August 25, 2005)
D3	DE-OS-3231240	(IDS dated August 25, 2005)
D4-	DE-OS-2133906	(IDS dated August 25, 2005)
D5	DE-OS-3015439	(IDS dated August 25, 2005)
D6	DE 197 07 332 C1	(IDS dated August 25, 2005)

- D9 Veröffentlichung der Firma Clariant „innovation - No Klebosol, No Chip", pp 26-29, 2/99 (IDS dated June 14, 2007)
D10 Pressemitteilung: Martin, S.C., Plant to Double Klebosol Capacity, 23 Februar 2001 (IDS dated January 22, 2007)
D15 Behnke, R. et al.: Kombinierte PVPP-/Kieselgelbehandlung. In: Brauwelt. Nürnberg: Hans Carl Verlag, 1977, Nr. 33, Seiten 1106 bis 1112 (IDS dated September 5, 2006)

- 1d. ☐ English language translation (complete or relevant portion(s)) of each non-English language publication.
- 1e. ☐ Explanations of Relevancy of References (ATTACHMENT 1(d), hereto) for providing a concise explanation of each non-English publication.
2. ☒ This Information Disclosure Statement is filed under 37 CFR §1.97(b) before the latter of three months after the U.S. patent application filing date or the first Office Action on the merits. Accordingly, no fee or §1.97(e) Statement is required.
3. ☐ This Information Disclosure Statement is filed under 37 CFR §1.97(c) after the first Office Action on the merits, but before a Final Office Action or a Notice of Allowance.
- 3a. ☐ The §1.97(e) Statement in Item 5 below is applicable. Accordingly, no fee is required.
- 3b. ☐ The \$180.00 fee set forth in 37 CFR §1.17(p) in accordance with 37 CFR §1.97(c) is to be charged to Deposit Account No. 50-3309.
4. ☐ This Information Disclosure Statement is filed under 37 CFR §1.97(d) after the Final Office Action or the Notice of Allowance, but before payment of the Issue Fee.
- ☐ The §1.97(e) Statement (Item 5 below) is applicable.
- A Petition to the Commissioner is hereby made under 37 CFR §1.97(d) to request consideration of this Information Disclosure Statement. The \$180.00 fee set forth in 37 CFR §1.17(i) is to be charged to Deposit Account No. 50-3309.
5. ☐ Statement Under §1.97(e) (*applicable if Item 3a or Item 4 is checked*)

- 5a. ☐ In accordance with 37 CFR §1.97(e)(1), it is stated that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
- 5b. ☐ In accordance with 37 CFR §1.97(e)(2), it is stated that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known by any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.
6. ☐ This is a continuation/divisional/continuation-in-part application under 37 CFR §1.153(b). (*Check appropriate Items 6a and/or 6b.*)
- 6a. ☐ Copies of the publications listed on Form PTO-1449 from prior Application Serial No. / , filed on , of which this application claims priority under 35 USC §120 have been omitted pursuant to 37 CFR §1.98(d).
- 6b. ☐ Copies of the publications listed on Form PTO-1449 which were not previously cited in prior Application Serial No. / , filed on , of which this application claims priority under 35 USC §120, are provided herewith.
- 6c. ☐ Copies of the following publications listed on Form PTO-1449 are not provided herewith as they were previously submitted either through an earlier Information Disclosure Statement or were cited on the International Search Report:
7. ☐ This is a continuation/divisional application under 37 CFR §1.53(d). (*Check either Item 7a or 7b.*)
- 7a. ☐ The Issue Fee has not been paid.

- 7b. ☐ A Petition to Withdraw from Issue under 37 CFR §1.313(b)(5) has been granted. A continuation application under 37 CFR §1.53(d) after payment of the Issue Fee is proper in accordance with 37 CFR §1.53(d)(1)(ii).
8. ☐ This is a Supplemental Information Disclosure Statement. *(Check either Item 8a or 8b.)*
- 8a. ☐ This Supplemental Information Disclosure Statement under 37 CFR §1.97(f) supplements the Information Disclosure Statement filed on _____. A bona fide attempt was made to comply with 37 CFR §1.98, but inadvertent omissions were made. These omissions have been corrected herein. Accordingly, additional time is requested so that this Supplemental Information Disclosure Statement can be considered as if properly filed on _____.
- 8b. ☐ This Supplemental Information Disclosure Statement is timely filed within one (1) month of the Notice under 37 CFR §1.97(i), mailed _____. (MPEP 609, Form ¶ 6.51, July 1997.)
9. ☒ In accordance with 37 CFR §1.98, a concise explanation of what is presently understood to be the relevance of each non-English language publication listed is:

(Check appropriate Items 9a, 9b, 9c, 9d, and/or 9e)

- 9a. ☐ satisfied because all non-English language publications were cited on the English language copy of the PCT International Search Report or the search report from a counterpart foreign application indicating the degree of relevance found by the foreign office, which was submitted with applicants' application papers and the receipt of which was acknowledged on the Rule 495 Notice of Acceptance, mailed 08/08/2005. (See U.S. Patent and Trademark Office's authorization in the Federal Register, Vol. 57, No. 12, January 17, 1992, at page 2031 (Reply to Comment 68)).

9b. ☒ Other information:

Synopsis of opposition:

The opponent alleged that silica sols according to the invention were known for the treatment of beverages before the priority date of the invention. To prove this, documents D9 (press release of Clariant dated February, 1999) and D10 (pages from Clariant publication dated February 23, 2001) were submitted. Both documents disclose that a colloidal silica under the trade name Klebosol has been used for clarifying wine and other beverages. Use of a Klebosol product is also made in the examples of the patent (EP 1520007B1).

Applicants point out that neither D9 nor D10 disclose any physio-chemical properties of the referenced Klebosol products.

The opponent further alleged that two series of documents collectively referred to as D11 and D12 demonstrate a use of the invention prior to the priority date of the patent (EP 1520007B1). D11 contains a product specification for a product called Blankasit®, labels, an analysis, and a certificate of the Forschungsanstalt Geisenheim (Research Institute Geisenheim) stating that the product Blankasit® of Erbslöh Geisenheim may be used for the treatment of wine and juice. D12 contains respective documents for the product Klar-Sol Super, also from Erbslöh Geisenheim. The documents indicate that they were amended after the priority date of the invention (patent EP 1520007B1).

For documents D13 and D14, it is noted that they are articles from journals and disclose the use of silica sols commercialized under the tradenames Blankasit® and Klar-Sol Super for clarifying wine and fruit juices. No physio-chemical details about the silica sols are given.

The opponent also alleged that for claim 7 of the patent (EP 1520007B1), the addition of PVPP is not based on an inventive step since documents D1, D2, and D15 already disclose the use of PVPP in combination with silica for clarification of beverages.

The opponent did not make any specific references in the opposition for documents D3 to D8 and D16 to D22, declaring that the relevance of those documents are self evident.

- 9c. ☒ satisfied because an English language translation (complete or relevant portion(s)) is attached to each non-English language publication.

Translation of product specification of Blankasit® (D11 in opposition).

Translation of product specification of Klar-Sol Super (D12 in opposition).

Summary of S. Görtges, Rohwareeinfluß auf Klärung und Stabilisierung beim Apfelsaft, Flüssiges Obst, 1/1980, pp 16-19, 46-52 (D13 in opposition).

Summary of H. Trogus, Weinklärung mit Kiesel-Gelatine-Schönungen, Der Badische Winzer, 9/1983, pp 468-72 (D14 in opposition).

Summary of Haushofer et al., Ergebnisse eines Großversuches mit dem Wein-Schönungsmittel Kieselsol, Mitt., 21, 1991 (D16 in opposition) can be found on page 375.

English language abstract of K. Wucherpennig und Ph. Possmann, Beitrag zure kombinierten Gelatine-Kieselsol-Schönung, Flüssiges Obst, 39, 1972 (D17 in opposition).

Summary of K. Raible et al., Behandlung der heißen Ausschlagwürze mit Kieselsol, Brauwelt Nr. 13, 1985, pp 540-546 (D18 in opposition) can be found on page 546.

Summary of Kieselsäuresol als Bierstabilisierungsmittel, Brauwelt Nr. 13, 1983, pp 495-497 (D19 in opposition).

Summary of G. Sommer und F. Boback, Verbesserung der Filtrierbarkeit, Brauwelt Nr. 4, 1988, pp 117-121 (D20 in opposition) can be found on page 121.

Summary of K. Raible et al., Kieselsäuresol - ein Bierstabilisierungsmittel zur Verbesserung der Filtrationseigenschaften von Bier, Monatsschrift für Brauwissenschaft, Heft 2, 1983, pp 76-82 (D21 in opposition) can be found on page 82.

Additional information of K. Raible et al., Kieselsäuresol - ein Bierstabilisierungsmittel zur Verbesserung der Filtrationseigenschaften von Bier, Monatsschrift für Brauwissenschaft, Heft 2, 1983, pp 76-82 (D21 in opposition).

Summary of K. Raible et al., Kieselsäuresol - ein Bierstabilisierungsmittel zur Verbesserung der Filtrationseigenschaften von Bier, Monatsschrift für Brauwissenschaft, Heft 3, 1983, pp 113-119 (D22 in opposition) can be found on page 119.

- 9d. ☐ the following equivalent English language publication is enclosed (or identified as a US patent):
- 9e. ☐ abstracts in the English language were previously submitted with Applicants' Information Disclosure Statement dated.
10. ☒ No admission is made that the information cited in this Statement is, or is considered to be, material to patentability nor a representation that a search has been made (other than search report(s) from a counterpart foreign application or a PCT International Search Report, if submitted herewith). 37 CFR §§1.97(g) and (h).

Serial No. 10/518,315
Filed December 16, 2004

11. ☐ The Commissioner is authorized to credit any overpayment or charge any additional fee required under 37 CFR §1.17 for this Information Disclosure Statement and/or Petition to Deposit Account No. 50-3309.

Respectfully submitted,



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Customer No. 26,289

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)

Applicant(s): Uwe FALK et al.

Docket No.

2002DE422

Serial No.

10/518,315

Filing Date

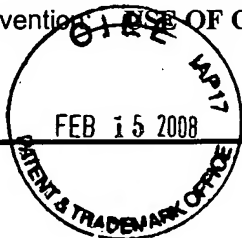
December 16, 2004

Examiner

To Be Assigned

Group Art Unit

1761

Invention: **USE OF COLLOIDAL ANIONIC SILICA SOLS AS CLARIFYING AGENTS**I hereby certify that this Information Disclosure Citation - 3 Pages

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is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The

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February 13, 2008

(Date)

MARIA T. SANCHEZ

(Typed or Printed Name of Person Mailing Correspondence)

A handwritten signature in cursive script, appearing to read "Maria T. Sanchez".

(Signature of Person Mailing Correspondence)

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CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)

Applicant(s): Uwe FALK et al.

Docket No.

2002DE422

Serial No.

10/518,315

Filing Date

December 16, 2004

Examiner

To Be Assigned

Group Art Unit

1761

Invention: **USE OF COLLOIDAL ANIONIC SILICA SOLS AS CLARIFYING AGENTS**

Copy of opposition filed against EP 1520007B1
(corresponds to present application) dated 12 December 2006
- 13 Pages

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February 13, 2008

(Date)

MARIA T. SANCHEZ

(Typed or Printed Name of Person Mailing Correspondence)

(Signature of Person Mailing Correspondence)

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